



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,763	04/23/1999	RAHN WOOD		2415

7590

06/06/2002

Kenyon & Kenyon
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 06/06/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/298,763

Applicant(s)

WOOD ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 17 January 2002 have been fully considered but they are not persuasive. Specific arguments are discussed with the following final rejection.

Claim Rejections - 35 USC § 102 and 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 USC 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-25 and 32-39 are rejected under 35 USC 102(b) as anticipated by Reilly et al.
5. Reilly et al. teaches a computer-implemented method and system for interactively and electronically distributing and redeeming rewards, the method comprising: displaying a headline image on a computer screen of a local computer, e.g., 230a in Fig. 6, the image comprising a reward indicator (col. 9 line 65 to col. 10 line 4), wherein the local computer is coupled to a computer network (Internet 119, col. 4 line 10); enabling a user to select an image (col. 13 lines 3-6); at a central location 104 coupled to the computer network, determining the identity of the user (col. 14 lines 24 and 50-58); at the central location, allocating to the user information associated with the image and in which the user has expressed interest (col. 14 line 58 to col. 15 line 4), which reads on allocating to the user a reward; and optionally redirecting the local computer to content associated with the image.

6. Applicant argues (last para. on p. 4) that reference col. 9, line 65, to col. 10 line 4, does not teach a “reward indicator”. MPEP § 2111.01 requires applicant to provide a “clear definition” of terms with special meaning. A “clear definition” must unambiguously establish what is and what is not included. It is helpful if definitions are gathered in a section labeled definitions, or are preceded by phrases such as “by xxx we mean”; “xxx is defined as”; or “xxx includes, ... but does not include ...”. In the instant case, the examiner is required to give the term its broadest reasonable interpretation (MPEP § 2111), which the examiner judges to be any indicator of a reward. Furthermore, examiner interprets “reward” to be anything desirable offered to the user. The information associated with the *headline 230a* is certainly desirable, so it reads on a reward, and *headline 230a* reads on a reward indicator. *Headline 230a* is also the “image” associated with the award.
7. Applicant also argues (p. 5 bottom) that “The claim language clearly represents that the ‘reward’ and the ‘content’ are two different features of the claim.” Examiner agrees that the claim language (last four lines, beginning at “at the central location”) represents that “reward” and “content” are two different structural features of the claim. But the reference reads on these two features. In terms of reference col. 4 lines 50-65, the “reward” is the *primary component* and the “content” is the *secondary component*.
8. Applicant also argues (p. 6) that the reference does not teach the claim 20 limitation to a database storing a list of available offers, and the claim 17 limitation to providing the user with a list of rewards associated with the user. Both lists are the same *list ... of categories and subcategories* taught by the reference at col. 4 line 43 and col. 9 lines 37-46.
9. Reilly et al. also teaches a profiler (col. 3 lines 15-16), which reads on a cookie; determining if the local computer comprises a datafile (claim 4, col. 14 lines 50-58); providing the local computer with the address of a promoter website (claims 5 and 8, col. 6 lines 5-6), and allowing the user to view information at that website, which reads on redeeming the reward at the promoter website; and updating the data feed, which reads on expiring the redeemed award (claim 9).
10. Applicant also argues (p. 6 bottom) that the reference does not teach the claim 16 limitation to printing/redeeming a reward at a physical location. That is taught by the “Print” button at the lower-left corner of Fig. 10. Applicant also argues (p. 6 bottom) that the reference does

Art Unit: 3622

not teach the claims 2, 3 and 23 limitation to cookies. As noted in the last paragraph, the reference teaches a profiler (col. 3 lines 15-16), which reads on a cookie.

11. Claims 26-31 are rejected under 35 USC 103(a) as obvious over Reilly et al.

12. Reilly et al. does not teach the user device limitations of these claims (ATM, PDA, etc.).

Official Notice is taken (MPEP § 2144.03) that these limitations were common at the time of the invention. In addition, Reilly et al. teaches implementing the invention as a screensaver (col. 11 line 40), which would attract users to any user device. Hence it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these user devices to the reference invention.

Suggestion of Allowable Subject Matter

13. The specification (p. 7 lines 3-5) discloses collecting rewards by clicking on an advertisement.

This is not taught or suggested by Reilly et al. Hence, the present rejection could be overcome by amending claim 1, line 4, to read "displaying an advertising image", and making similar amendments to the other independent claims.

14. Applicant is cautioned that an allowance could not be considered until this or any other amendment were searched.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3622

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
18. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular official communications and 703-746-7238 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.
19. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

5 June 2002

18 March 2002



Donald L. Champagne
Examiner
Art Unit 2162